

**REMARKS**

This Application has been carefully reviewed in light of the Office Action mailed August 25, 2004 ("Office Action"). In the Office Action, Claims 1-9 are pending in the Application and the Examiner rejects Claims 1-9. Applicant has amended Claim 1 and added new Claims 21-34. Applicant submits that no new matter has been added with these amendments. As described below, Applicant believes all claims to be allowable over the cited references. Therefore, Applicant respectfully requests reconsideration and full allowance of all pending claims.

**Section 101 Rejections**

The Examiner rejects Claims 1-8 under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. Specifically, the Examiner states that the claims "fail to incorporate sufficiently clear technological art devices, e.g. computer implementation, to effect the recited steps." (Office Action, page 2). Applicant respectfully traverses this rejection of Claims 1-8 and requests reconsideration and favorable action.

The patent laws define patentable subject matter as "any new and useful process, machine, manufacture or composition of matter, or any new and useful improvement thereto." See 35 U.S.C. § 101. When an abstract idea is reduced to a practical application, the abstract idea no longer stands alone if the practical application of the abstract idea produces a useful, concrete and tangible result. This then satisfies the requirements of 35 U.S.C. § 101. See *In re Alappat*, 33 F.3d 1526, 31 U.S.P.Q. 2d 1545, 1558 (Fed. Cir. 1994); see also *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 47 U.S.P.Q. 2d 1596, 1601-02 (Fed. Cir. 1998) and the PTO guidelines available at [www.uspto.gov/web/menu/pbmethod/trangmaterials.ppt](http://www.uspto.gov/web/menu/pbmethod/trangmaterials.ppt). While an abstract idea by itself may not satisfy the requirements of 35 U.S.C. § 101, an abstract idea when practically applied to produce a useful, concrete, and tangible result satisfies 35 U.S.C. § 101. See *AT&T Corp. v. Excel Comm. Inc.*, 172 F.3d 1352, 1357, 50 U.S.P.Q. 1447, 1452 (Fed. Cir. 1999) (stating that as technology progressed, the CCPA overturned some of the earlier

limiting principles regarding § 101 and announced more expansive principles formulated with computer technology in mind); see also *In re Musgrave*, 431 F.2d 882, 167 U.S.P.Q. 280 (CCPA 1970) (cited by the Federal Circuit in *AT&T Corp.*, 172 F.3d at 1356). Thus, producing a useful, concrete, and tangible result is the key to patentability according to *State Street* and other applicable case law.

Applicant respectfully submits that independent Claim 1 produces a useful, concrete, and tangible result. "Only when the claim is devoid of any limitation to a practical application in the technological arts should it be rejected under 35 U.S.C. 101." M.P.E.P. § 2106. Indeed, a method or process remains statutory even if some or all of the steps therein can be performed in the human mind, with the aid of the human mind, or because it may be necessary for one performing the method or process to think. See *In re Musgrave*, 431 F.2d at 893, 167 U.S.P.Q. at 289. Furthermore, although Applicant believes Claims 1-8 recite allowable subject matter as originally filed, Applicant has made clarifying amendments to independent Claim 1 in order to address the Examiner's concern. For example, Applicant has amended Claim 1 to recite "gathering a transaction history data associated with the identified user from a computerized database" and "displaying the transaction history associated with the identified user to the user on a computerized system." Additionally, Applicant has amended Claim 1 to recite "initiating a returns process in response to a selection, by the user, of a transaction displayed in the transaction history, the selection comprising input into the computerized system." In no way should such amendments be construed as acquiescence to the Examiner's contentions regarding these independent claims.

For at least the reasons discussed above, Applicant respectfully requests that Examiner's rejection of Claims 1-8 under 35 U.S.C. § 101 be withdrawn

### **Section 102 Rejections**

The Examiner rejects Claims 1-7 and 9 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application No. 2001/0032143 issued to Haseltine

(“*Haseltine*”). Applicant respectfully traverses these rejections for the reasons stated below.

Independent Claim 1, as amended, recites as follows:

A method for processing the returns of merchandise purchased through the World Wide Web comprising:  
identifying a user;  
gathering transaction history data associated with the identified user from a computerized database;  
displaying the transaction history associated with the identified user to the user on a computerized system; and  
initiating a returns process in response to a selection, by the user, of a transaction displayed in the transaction history, the selection comprising input into the computerized system.

In order to establish a *prima facie* case of anticipation, all the elements of the claimed invention must be found within a single prior art reference. *Dewey & Almy Chemical Co. v. Mimex*, 124 F.2d 986, 52 U.S.P.Q. 138 (2d Cir. 1942). In addition, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claims” and “[t]he elements must be arranged as required by the claim.” *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989); *In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); M.P.E.P. § 2131 (*emphasis added*). Applicant respectfully submits that *Haseltine* does not disclose, teach, or suggest each and every element of independent Claim 1.

For example, *Haseltine* does not disclose, teach, or suggest “gathering a transaction history data associated with the identified user from a computerized database” and “initiating a returns process in response to a selection, by the user, of a transaction displayed in the transaction history, the selection comprising input into the computerized system,” as recited in Applicant’s Claim 1. Rather, the return system disclosed in *Haseltine* uses “a distributed network of point-of-return affiliates who will accept the e-tailer’s returns on a walk-in basis in such associate’s brick-and-mortar store.” (Page 2, paragraph 18). Specifically, “the buyer orders a given product 20 or a set of products.” (Page 2, paragraph 25). “The e-tailer prepares (or has prepared) the order for shipment by

what is called a fulfillment process 24.” (Page 2, paragraph 26). “During the fulfillment process, an inventive packing slip 26 is developed and applied to the given product.” (Page 2, paragraph 26). “Preferably, the inventive packing slip comprises a point-of-fulfillment generated bar code” and “is affixed by any suitable means to as much of the product that comprises a discrete, returnable unit.” (Page 2, paragraph 26). When the purchaser desires to return the product, the purchaser “is informed by means of any various avenues of media, that the e-tailer participates in an association 40 such that the e-tailer has a distributed network of point-of-return affiliates 42 who will accept the return on a walk-in basis.” (Page 3, paragraph 34). “Such affiliates 42 might be the private mailing enterprises that dot the country, including without limitation, PACK ‘N’ MAIL, or MAIL BOXES ETC, and so on.” (Page 3, paragraph 34).

“The point-of-return associate 42 provides walk-in processing of the primary target’s request for return.” (Page 3, paragraph 35). “The point-of-return associate reads or otherwise enters the immediate message given by the inventive bar-coded packing slip 26.” (Page 3, paragraph 35). Thus, the point-of-return associate 42 at the affiliated mailing enterprise receives the packing slip from the purchaser, and the point-of-return associate 42, rather than the purchaser, reads or scans the barcode. The “electronic packing slip includes precise information if not instructions to the point-of-return associate.” (Page 3, paragraph 35). “Such information or instructions will guide this point-of-return associate on how to properly authorize the return of the given product of this e-tailer.” (Page 3, paragraph 35). Accordingly, the system disclosed in *Haseltine* provides a return service by which a packing slip is received by a third-party mailing enterprise or other brick-and-mortar entity for returns processing. As a result, *Haseltine* cannot be said to disclose, teach, or suggest “gathering a transaction history data associated with the identified user from a computerized database” and “initiating a returns process in response to a selection, by the user, of a transaction displayed in the transaction history, the selection comprising input into the computerized system,” as recited in Applicant’s Claim 1.

For at least these reasons, Applicant respectfully requests reconsideration and allowance of Claim 1, together with Claims 2-7 and 9 that depend from Claim 1.

### **Section 103 Rejections**

The Examiner rejects Claims 1 and 8 under 35 U.S.C. § 103(a) as being unpatentable over *Haseltine*. Applicant respectfully traverses these rejections for the reasons stated below.

Regarding Claim 1, Applicant has provided a detailed discussion of *Haseltine* above with regard to the Examiner's rejection of Claim 1 under 35 U.S.C. § 103(a). Because Applicant has shown above that *Haseltine* does not disclose, teach, or suggest each and every element of Applicant's Claim 1, Applicant has not provided further arguments regarding Claim 1 and *Haseltine* here.

Dependent Claim 8 depends upon independent Claim 1, which Applicant has shown above to be allowable. Accordingly, dependent Claim 8 is not obvious over the proposed combination at least because Claim 8 includes the limitations of independent Claim 1. Additionally, dependent Claim 8 recites elements that further distinguish the art. For example, Claim 8 recites "auctioning the merchandise selected for return by the user." The Examiner has not provided any indication of where the combination of recited features are disclosed in *Haseltine*. Rather, the Examiner has merely states that *Haseltine* discloses "the problem with returns in that the customer and client may be separated by the entire breadth of the country making shipping for small products, e.g. cookies (paragraph 0026) non cost effective." (Office Action, page 5). However, Applicant respectfully submits that the Examiner has taken the relied upon section out of context. The portion of *Haseltine* relied upon by the examiner merely states that the "bar-coded packing slip is affixed by any suitable means to as much of the product that comprises a discrete, returnable unit." (Page 2, paragraph 26). As an example, *Haseltine* provides that "if the returnable unit comprises a box of cookies, then it is the box and not the cookies which are affixed with the bar code." (Page 2, paragraph 26). Accordingly, the portion of *Haseltine*

relied upon by the Examiner does not provide the suggestion or motivation to modify *Haseltine* as the Examiner states. Certainly, *Haseltine* does not suggest that “it would be an obvious choice to try to sell the product for the best possible price so as not to incur a total loss and the old and notorious way of effecting this is the use of an auction,” as suggested by the Examiner.

Moreover, assuming for the purposes of argument that *Haseltine* discloses the features and operations of Claims 1 and 8 (which Applicant disputes above), the rejection of Claims 1 and 8 is improper at least because the Examiner has not shown a suggestion or motivation in the references or in the knowledge generally available to one of ordinary skill in the art to modify *Haseltine*, which is required by the M.P.E.P. “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of the combination.” M.P.E.P. § 2143.01. Nothing in *Haseltine* suggests or motivates the proposed modification, nor has the Examiner provided any evidence that suggests the proposed modification. If the Examiner is relying on “common knowledge” or “well known” art in support of his rationale for modifying the references, the Examiner is requested to produce a reference in support of his position pursuant to M.P.E.P. § 2144.03. If the Examiner is relying on personal knowledge to supply the required motivation to modify, Applicant respectfully requests that the Examiner produce an affidavit supporting such facts pursuant to M.P.E.P. § 2144.03. Without such independent suggestion, the art is to be considered as merely inviting unguided and speculative experimentation which is not the standard with which obviousness is determined. *Agmen Inc. v. Chugai Pharmaceutical Co., Ltd.*, 927 F.2d 1200, 18 U.S.P.Q.2d 1016 (Fed. Cir. 1991).

For at least these reasons, Applicant respectfully requests reconsideration and allowance of Claim 8.

**New Claims 21-34 are Allowable**

New Claims 21-34 have been added and are fully supported by the original specification. No new matter has been added. Because *Haseltine* does not disclose, teach, or suggest the combination of features recited in Applicant's New Claims 21-34, Applicant respectfully submits that New Claims 21-34 are allowable over the prior art of record. For example, new independent Claim 21 recites "initiating a returns process in response to a selection, by the user, of a transaction displayed in the transaction history, the selection comprising input by the user into the computerized system." As another example, new independent Claim 34 recites "initiating a returns process in response to a selection, by the user, of a transaction displayed in the transaction history, the selection comprising input by the user into the computerized system." For reasons similar to those described above with regard to Claim 1, these elements are not disclosed, taught, or suggested by *Haseltine*. Accordingly, Applicant respectfully submits that new Claims 21-34 are allowable over the prior art.

ATTORNEY DOCKET NO.  
067439.0111

PATENT APPLICATION  
09/817,353

16

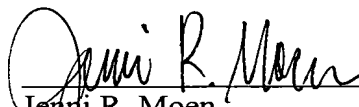
**CONCLUSION**

Applicant has made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicant respectfully requests full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Jenni R. Moen, Attorney for Applicant, at the Examiner's convenience at (214) 953-6809.

A check for \$27.00 is attached to cover the cost of additional claims. Applicant believes that no additional fees are due. However, the Commissioner is hereby authorized to charge any additional fees or credit any overpayment to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,  
BAKER BOTTS L.L.P.  
Attorneys for Applicant

  
\_\_\_\_\_  
Jenni R. Moen  
Reg. No. 52,038

Date: November 23, 2004

Correspondence Address:

at Customer No. **05073**